

Remarks

This Application has been carefully reviewed in light of the Office Action mailed September 10, 2007. Although Applicant believes all claims are allowable without amendment, to advance prosecution Applicant has made clarifying amendments to independent Claims 1, 13, and 25. These amendments are not considered necessary for patentability. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. Claim 34 is Allowable over *Spilo*

The Examiner rejects Claim 34 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,208,999 to Spilo, et al. ("*Spilo*"). Applicant respectfully disagrees.

"A claim is anticipated only if *each and every element as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. § 2131. In addition, "[t]he identical invention must be shown in *as complete detail as contained in the . . . claim.*" *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added); *see also* M.P.E.P. § 2131. Furthermore, "[t]he elements must be arranged *as in the claim* under review." *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) (emphasis added); M.P.E.P. § 2131. As illustrated below, *Spilo* does not appear to disclose, either expressly or inherently, each and every limitation recited in Claim 34, as is required under the M.P.E.P. and governing Federal Circuit cases.

Independent Claim 34 recites:

- A serverless backup method comprising:
 - opening a file system root directory;
 - parsing the file system root directory for allocation tables of each file and finding attributes of each file;
 - examining the attributes of each file and determining whether a file is resident or non resident;
 - backing up entire attributes of a file if it is determined that the file is resident; and
 - backing up attributes and data blocks belonging to the file if it is

determined that the file is non resident.

Applicant respectfully submits that *Spilo* does not appear to disclose, teach, or suggest each and every limitation recited in Claim 34.

For example, Applicant respectfully submits that the cited portions of *Spilo* fail to disclose, teach, or suggest “determining whether a file is resident or non resident” and “backing up entire attributes of a file if it is determined that the file is resident,” as recited in Claim 34. As allegedly disclosing these limitations, the Examiner cites *Spilo*, 4:66-5:11, emphasizing the following particular language: (1) “[T]he disk can be scanned to find missing files;” and (2) “File allocation information can be dynamically maintained and can be reconstructed in cases of loss or damage by scanning the disk for blocks having identification and sequence numbers.” (Office Action at 3)

First, the disclosure that “file allocation information can be dynamically maintained and can be reconstructed in cases of loss or damage by scanning the disk for blocks having identification and sequence numbers” does not appear to disclose, teach, or suggest “backing up entire attributes of a file if it is determined that the file is resident,” as recited in Claim 34. There simply does not appear to be a back up of entire attributes of a file based on a determination that a file is resident in the cited portion of *Spilo*.

Second, even assuming for the sake of argument only that the disclosure in *Spilo* of “the disk can be scanned to find missing files” can be equated with the recitation of “determining whether a file is resident or non resident,” as recited in Claim 34 (which Applicant does not concede), it is unclear to Applicant how this determination impacts the portion of *Spilo* that the Examiner cites as allegedly disclosing “backing up entire attributes of a file *if it is determined that the file is resident*,” as recited in Claim 34. For example, how does any determination made by scanning the disk to find missing files affect the file allocation information being dynamically maintained and being reconstructed in cases of loss or damage? Applicant’s claim recites that a determination is made “whether a file is resident or non resident” and entire attributes of a file are backed up “*if it is determined that the file is resident*,” as recited in Claim 34. It does not appear that the cited portion of *Spilo* discloses,

teaches, or suggests these limitations.

As another example, Applicant respectfully submits that the cited portions of *Spilo* fail to disclose, teach, or suggest “determining whether a file is resident or non-resident” and “backing up attributes and data blocks belonging to the file if it is determined that the file is non resident,” as recited in Claim 34. As allegedly disclosing the second of these limitations, the Examiner cites *Spilo*, 5:12-25, emphasizing the particular language “only a small portion of each data file block is devoted to the information used to recreate the file and directory structures.” (Office Action at 4) The cited portion of *Spilo* appears to disclose merely that in order to provide the purportedly improved data protection offered by the system disclosed in *Spilo*, only a small portion of stored data blocks must include information to provide this capability (information used to recreate the file and directory structures). (*Spilo*, 5:12-25) However, it does not appear to Applicant that the cited portion discloses, teaches, or suggests “backing up attributes and data blocks belonging to the file if it is determined that the file is non resident [based on a determination of whether the file is resident or non resident,” as recited in Claim 34.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 34.

II. Claims 1, 13, and 25 and Their Dependent Claims are Allowable over the Proposed *St. Pierre-Ofek* Combination

The Examiner rejects Claims 1-4, 13-16, and 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,366,986 to St. Pierre, et al. (“*St. Pierre*”), in view of U.S. Patent 6,385,706 to Ofek, et al. (“*Ofek*”). Applicant respectfully traverses these rejections and discusses amended independent Claim 1 as an example.

A. Obviousness Standard

Applicant respectfully disagrees with the Examiner and submits that the Examiner has not established a *prima facie* case for obviousness with respect to Claims 1, 13, and 25 and their dependent claims based on the teachings of *St. Pierre* and *Ofek*.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. ch. 2143.03 (citations omitted). In addition, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole still cannot be said to be obvious without some reason why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

B. The Proposed *St. Pierre-Ofek* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claims 1, 13, and 25

The proposed *St. Pierre-Ofek* combination fails to disclose, teach, or suggest at least the following limitations recited in Claim 1, as amended:

a backup storage system for backing up the information, the backup storage system coupled to the storage system and to one or more servers via a network;

wherein:

the information being backed up is transferred *using one or more data movers* operable to transfer the information being backed up directly from the storage system to the backup storage system without going through the one or more servers; and

the information being restored is transferred *using one or more data movers* operable to transfer the information being restored directly from the backup storage system to the storage system without going through the one or more servers.

As allegedly disclosing the limitations recited in Claim 1 prior to the amendments presented in this Response, the Examiner cites various portions of both *St. Pierre* and *Ofek*. (Office Action at 4-6) For example, the Examiner cites Figure 22 of *St. Pierre* and its associated text, particularly identifying storage system 221, mirror backup storage system 222, and link 224 (*see St. Pierre*, 26:16-35). As another example, the Examiner cites a portion of *Ofek* disclosing that host computers 80 are coupled to the enterprise storage 89

through a network or directly to primary storage nodes 82. (See Office Action at 5-6 citing *Ofek*, 14:29-37)

It does not appear that the cited portions of either *St. Pierre* or *Ofek* disclose, teach, or suggest these limitations. For example, it does not appear that the cited portions of either *St. Pierre* or *Ofek* disclose, teach, or suggest that “the information being backed up is transferred *using one or more data movers operable to transfer the information being backed up directly from the storage system to the backup storage system without going through the one or more servers*,” as recited in Claim 1 as amended. As another example, it does not appear that the cited portions of either *St. Pierre* or *Ofek* disclose, teach, or suggest that “the information being restored is transferred *using one or more data movers operable to transfer the information being restored directly from the backup storage system to the storage system without going through the one or more servers*,” as recited in Claim 1 as amended.

For at least these reasons, Applicant respectfully submits that the proposed *St. Pierre-Ofek* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 1.

Claims 13 and 25 recite analogous use of one or more data movers to transfer information being backed up or restored directly from or to the storage system to or from the backup storage system without going through the one or more servers. Thus, for at least certain analogous reasons, Applicant respectfully submits that the proposed *St. Pierre-Ofek* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claims 13 and 25.

III. The Separately-Rejected Dependent Claims are Allowable over the Proposed Combinations

The Examiner rejects Claims 5, 17, and 26 under 35 U.S.C. § 103(a) as being unpatentable over *St. Pierre* and *Ofek* in view of U.S. Patent 6,728,848 to Tamura (“*Tamura*”). The Examiner rejects Claims 6-7, 18-19, and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over *St. Pierre* and *Ofek* in view of U.S. Patent 6,081,875 to Clifton, et al. (“*Clifton*”). The Examiner rejects Claims 8-9, 20-21, and 29-30 under 35 U.S.C. § 103(a) as

being unpatentable over *St. Pierre*, *Ofek*, and *Clifton* in view of U.S. Patent 6,785,786 to Gold, et al. ("*Gold*"). The Examiner rejects Claims 10-12, 22-24, and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over *St. Pierre*, *Ofek*, *Clifton*, and *Gold*.

At the outset, Applicant notes that there appears to be an inconsistency in the rejection of Claims 10-12, 22-24, and 31-33. The introductory paragraph identifying the references on which the rejections is based states that the rejection is based on *St. Pierre*, *Ofek*, *Clifton*, and *Gold*. (Office Action at 12) (emphasis added) However, the substance of the rejection refers to a *Blam* reference. If a subsequent Office Action should issue instead of a Notice of Allowance, Applicant respectfully requests that the Examiner clarify the rejection of these claims.

In any event, dependent Claims 5-12, 17-24, and 26-33 depend from independent Claims 1, 13, and 25, respectively, which Applicant has shown above to be allowable over the proposed *St. Pierre-Ofek* combination. The Examiner does not allege that the references cited to reject dependent Claims 5-12, 17-24, and 26-33 make up for the above-discussed deficiencies of the proposed *St. Pierr-Ofek* combination. Thus, dependent Claims 5-12, 17-24, and 26-33 are allowable at least because they depend from allowable independent claims. Additionally, depend Claims 5-12, 17-24, and 26-33 recite further patentable distinctions over the various references cited by the Examiner. To avoid burdening the record and in view of the clear allowability of independent Claims 1, 13, and 25, Applicant does not specifically discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Moreover, Applicant does not admit that the proposed combinations of references are possible or that the Examiner has provided an adequate reason for combining or modifying the references.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 5-12, 17-24, and 26-33.

IV. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

Conclusion

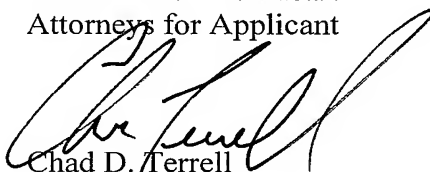
Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Although no fees are believed due, the Commissioner is hereby authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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